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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,166	01/27/2006	Shinichi Nakamura	03500103118	2518

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

YOUNG, SHAWQUA

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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10/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,166

Applicant(s)

NAKAMURA, SHINICHI

Examiner

Shawquia Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 6-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/23/06, 3/22/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-18 are currently pending in the instant application.

I. *Priority*

The instant application is a 371 of PCT/JP05/01438, filed on January 26, 2005 and claims benefit of Foreign Application JAPAN 2004-018357, filed on January 27, 2004.

II. *Information Disclosure Statement*

The information disclosure statements (IDS) submitted on October 23, 2006 and March 22, 2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been fully considered by the examiner.

III. *Restriction/Election*

A. *Election: Applicant's Response*

Applicants' election with traverse of claims 1-5 as drawn to Formula VI where A₁ is a single bond, A₂ is thiophene, A₃ is a single bond and A₄ is thiophene in the reply filed on August 27, 2007 is acknowledged. The traversal is on the ground(s) that: (1) that claims 1 to 5 recite Markush groupings for alternatives of chemical compounds.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121 and 372. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be

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independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Applicants argue that claims 1 to 5 of the present application recite Markush groupings for alternatives of chemical compounds. Applicants further argue that according to MPEP 1850(III)(B), the chemical compounds shall be regarded as being of a similar nature where (1) all alternatives have a common property or activity and (2) a common structure is present i.e., a significant structural element is shared by all of the alternatives. However the Examiner wants to point out that all of alternative do not have a common structure. According to Applicants' claim 2, various structural formulae are encompassed by claim 1 including General Formulas (III) to (VII). All of general formulas (III) to (VII) listed in claim 2 do not have a common structure. For example, prior art that reads on general formula (III) would not necessarily read on general formula (V) or (VII). Applicants argue that the fact that the compounds are pi-conjugate and contain two or more thiophene rings shows that the compounds have a common structure. However, the Examiner wants to point out that the special technical feature in the instant claims would be two thiophene rings connected because that is what is common in all of the compounds embraced by the claims and does not vary. Therefore the restriction requirement is deemed proper and **MADE FINAL**.

Subject matter not encompassed by elected Group drawn to Formula VI where A₁ is a single bond, A₂ is thiophene, A₃ is a single bond and A₄ is thiophene are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to

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nonelected inventions.

IV. Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, variable m is defined as an integer of 2 or more but does not of have an upper limit. The claims do not define clearly what is encompassed by the variable m.

V. Objections

Claim Objection-Non Elected Subject Matter

Claims 1-5 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject

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matter claimed and shall not serve as a basis for any other multiple dependent claim.

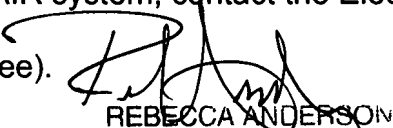
See MPEP § 608.01(n). Accordingly, the claim 5 has not been further treated on the merits.

VI. Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 6:30 AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^{re}Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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